

REMARKS

Claims 1-15, 22 and 23 are pending for prosecution in the above-identified patent application. In the Office Action of December 3, 2003, the Examiner rejected claims 1-5, 11-12, 15, and 22-23. The Examiner objected to claims 6-10 and 13-14. In response, the Applicant has cancelled claim 23 above and provides the following remarks that address the Examiner's rejections.

With respect to paragraph 3 of the Office Action, the Examiner rejected claims 22 and 23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,451,423 to Priese (hereinafter "the Priese patent"). Specifically, in rejecting these claims, the Examiner noted:

...the pressure responsive valve actuator include[es] an indicator member. Priese clearly shows and discloses in column 4, lines 23+, an indicator, pin 106 (a moving member) responsive to fluid pressure moving via a piston 56 together with a working rod "...for operating a valve element..." 52, 56 to indicate valve actuation. The pin (visual checking member) 76 clearly projects out of and retreats into the housing 32 and 82.

Applicant disagrees with the rejection and submits that the Priese patent does not disclose each and every element of independent claims 1 and 22. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). Accordingly, Applicant respectfully traverses the rejection below.

With regard to independent claims 1 and 22, both claims require, *inter alia*, a biasing member that biases the working rod. Specifically, claims 1 and 22 recite (emphasis added), respectively, as follows:

1. A stop valve comprising:
 - a working rod for operating a valve element which is moved to close and open a main conduit;
 - a biasing member which biases said working rod in a direction to make said valve element one of close and open said main conduit;
 - a piston body which is coupled to said working rod and slidably fitted in a housing of said stop valve;
 - a pressure chamber formed within said housing be said piston body;
 - a pressure supplying device which supplies a working fluid to said pressure chamber to move said working rod in a direction against a biasing force of said biasing member; and
 - a visual checking member which is integral with said working rod to project from said housing in accordance with movement of said working rod, wherein an amount of projection of said visual checking member varies in accordance with an axial position of said working rod.

22. A stop valve comprising:
 - a working rod for operating a valve element which is moved to close and open a conduit;
 - a biasing member which biases said working rod in a first direction to make said valve element close said conduit;
 - a pressure chamber formed within a housing of said stop valve;
 - a pressure supplying device which supplies a working fluid to said pressure chamber to move said working rod in a second direction against a biasing force of said biasing member; and
 - a moving member which moves together with said working rod to project out of and retreat into said housing in accordance with movement of said working rod.

Therefore, in order for the Priese patent to anticipate independent claims 1 and 22 of the present patent application, the Priese patent must disclose each and every recitation of the claims, including, *inter alia*, a biasing member that biases the working rod.

The Priese patent does not disclose the biasing member as described in claims 1 and 22. Furthermore, the Examiner has not pointed to an element or section in the Priese patent in which a biasing member is shown or described. Accordingly, because the Priese patent lacks one or more of the recitations of both claims 1 and 22, the Priese patent can not form the basis for a 35 U.S.C. §102(b) rejection. Favorable reconsideration is, therefore, requested.

Claims 2-4, and 15 are all dependent, directly or indirectly, on claim 1. Therefore, Applicant submits that these claims are allowable in the same way as claim 1, as well as by virtue of the additional recitations clearly set forth therein. Favorable reconsideration of claims 1-5, 11-12, 15 and 22 is respectfully requested.

With regard to paragraph 5 of the Office Action, the Examiner has objected to claims 6-10, 13 and 14 because each depends, directly or indirectly, upon rejected claim 1. However, based on arguments above, the Applicant submits that claim 1 is drawn to allowable subject matter. Therefore, the Applicant respectfully requests that the Examiner's objection to claims 6-10, 13 and 14 be withdrawn.

Applicant believes that no additional fees are due with the present Response; however, please charge any deficiencies that may exist to Deposit Account No. 13-0235. Applicant respectfully requests that the Examiner contact the Applicant's representative at the phone number listed below should the Examiner have any questions regarding the present Response.

Respectfully submitted,

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